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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91225104
Party	Defendant Atmos Nation LLC
Correspondence Address	DIVYA KHULLAR USAPATENTS.COM 4786 W COMMERCIAL BLVD TAMARAC, FL 33319-2878 UNITED STATES dkhullar@notices.com, sbrito@khullarlaw.com, assistant@usapatents.com
Submission	Answer
Filer's Name	Divya Khullar, Esq.
Filer's e-mail	dkhullar@usapatents.com, notices@khullarlaw.com, assistant@usapatents.com
Signature	s/Divya Khullar/
Date	03/14/2016
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In re Serial No. 86/604,124
Published: August 4, 2015

DRL ENTERPRISES, INC.)	
Opposer,)	Opposition No. 91225104
v.)	Mark: I50
ATMOS NATION LLC,)	
Applicant.)	

**APPLICANT’S ANSWER TO OPPOSER’S NOTICE OF OPPOSITION AND
INCORPORATED AFFIRMATIVE DEFENSES**

Applicant, ATMOS NATION LLC, (hereinafter “Atmos Nation”) for its answer and incorporated counterclaims to the Notice of Opposition filed by Opposer, DRL ENTERPRISES, INC. (hereinafter “DRL”) against application for registration of ATMOS NATION’s trademark I50, Serial No. 86/604,124 published in the Official Gazette of the United States Patent and Trademark Office on August 4, 2015, pleads and avers as follows:

APPLICANT’S ANSWER TO OPPOSER’S NOTICE OF OPPOSITION

1. Answering paragraph 1 of the Notice of Opposition, Applicant lacks knowledge or information sufficient to form a belief as to the truth of the allegations contained therein and neither admits nor denies the allegations.

2. Answering paragraph 2 of the Notice of Opposition, Applicant lacks knowledge or information sufficient to form a belief as to the truth of the allegations contained therein and neither admits nor denies the allegations.

3. Answering paragraph 3 of the Notice of Opposition, Applicant lacks knowledge or information sufficient to form a belief as to the truth of the allegations contained therein and neither admits nor denies the allegations.

4. Answering paragraph 4 of the Notice of Opposition, Applicant lacks knowledge or information sufficient to form a belief as to the truth of the allegations contained therein and neither admits nor denies the allegations.

5. Answering paragraph 5 of the Notice of Opposition, Applicant denies the allegations contained therein.

APPLICANT'S AFFIRMATIVE DEFENSES TO OPPOSER'S NOTICE OF OPPOSITION

Applicant, ATMOS Nation, and for its counterclaims against Opposer, pleads and avers as follows:

I. INTRODUCTION

1. The applicant, ATMOS, is a well-known provider of vaporizers and related accessories (herein after "Vaporizer Products").

2. ATMOS is in the business of designing, marketing, and selling portable vaporizers, e-cigarettes, and their accessories throughout the United States and the World under the brand name ATMOS RX®.

3. Vaporizers provide their users with a healthier way to inhale tobacco, eucalyptus, hops, chamomile, lavender, lemon, balm, sage, thyme, aromatherapy, dry herbs, and aromatic oils with a reduced negative impact on their health. Vaporizers break down substances into a vapor. Vaporization releases the essential, active elements of a substance, and virtually eliminates second hand smoke.

4. ATMOS is among the most prominent, best-selling, and innovative vaporizer companies in the United States and throughout the World. ATMOS have over forty registered Trademarks in US and some of these trademarks have been extended to other prominent economies around the world. ATMOS' intellectual property portfolio extends beyond just trademark to over thirty patents/applications and numerous copyrights.

5. ATMOS filed the mark i50 (Application Serial No. 86/604,124) (the "Mark"), on April 21, 2015. The Mark was published in the Official Gazette of the United States Patent and Trademark Office on August 4, 2015.

6. The Application for the mark "i50" is for "Electronic cigarettes; Electronic cigars; Electronic hookahs; Electronic smoking pipes; Mechanical electronic cigarettes; Smokeless cigarette vaporizer pipe" in CLASS 34 based on an intent to use the mark in the United States.

7. Specifically, Applicant's mark of "i50" is used to market a product known as the "Atmos 510 i50 box mod."

8. The Atmos 510 i50 box mod is an aromatherapy vaporizer used for the purposes of aromatherapy only.

9. DRL (the "Opposer") engage in the business of distributing cigarette rolling papers.

10. Specifically, Opposer's marks of "1.0", "1.25", and "1.5" are used to market rolling papers which are sold as "1.0's", "1.25's", and "1.5's".

11. Opposer's products are used for the purposes of rolling tobacco and/or other leaf-based products.

II. OPPOSER AND APPLICANT'S MARK DO NOT SHARE THE SAME CHARACTERISTICS—OPPOSER USES NUMBERS AND A STYLIZED "POINT", WHILE APPLICANT USES A COMBINATION OF LETTERS AND NUMBERS, AND DOES NOT CONTAIN A "POINT"

12. Applicant realleges paragraph 1-11 against the notice of opposition as paragraph 12 of this section.

13. Applicant's mark of "i50" can be stylized as "i50" "i 50" "I50", or "I 50". The mark is to be read literally as "eye-fifty".

14. Opposer's "One Marks" are stylized as "1.0 (point)", "1.25 (point)", and "1.5 (point)". The mark is to be read literally as containing a point. Therefore, when a consumer reads the name aloud, it is to be read as "one-point-zero", "one-point-two-five (or twenty-five)", and "one-point-five".

15. When analyzing Applicant's and Opposer's marks objectively, a reasonable consumer would not be confused by the two marks, as Opposer's mark uses only roman numerals, and Applicant's mark uses a combination of roman numerals and roman alphabet.

16. Applicant neither incorporates the stylized "point" into its mark, which is an attribute Opposer highly values, as the "point" is an obvious part of the mark, linguistically and in design.

17. If Opposer, in its use of only numbers, is allowed to acquire protection against a mark that incorporates numbers **and** letters, this would lead to a flood of litigation resting solely on the fact that a consumer was confused by a letter that looked similar to a number or vice versa. This leads to an unconscionably large blanket of protection for any trademark owner incorporating numbers into their mark.

18. Consequently, as a result of Opposer and Applicant's marks being entirely different in design, there is no likelihood of confusion between the marks, precluding protection for Opposer's mark under the Lanham Act.

III. OPPOSER'S MARK IS WEAK AND DOES NOT AFFORD PROTECTION UNDER THE LANHAM ACT BECAUSE THE MARK IS DESCRIPTIVE

19. Applicant realleges paragraph 1-18 against the notice of opposition as paragraph 19 of this section.

20. "The primary indicator of strength [of a trademark] measures the logical correlation between a name and a product. If a seller of a product or service would naturally use a particular name, it is weakly protected." Gaeta Cromwell, Inc. v. Banyan Lakes Vill., 523 So. 2d 624, 624 (Fla. 4th DCA 1988).

21. Opposer's trademarks of "1.0", "1.25", and "1.5" are exactly what the product is: pieces of paper that are in length of 1 inch, 1.25 inches, and 1.5 inches. A piece of paper can be sold anywhere. If a consumer is looking to purchase post-it notes, they may ask for a "1.25", signifying post-it notes of that size.

22. Opposer's mark of "1.0", for example, is the trademark for Opposer's rolling papers that are 1 inch in length.

23. At Home Depot, often times a consumer asks for a "2x4", signifying a piece of wood that is 2 by 4 inches. This is the same as a consumer asking for a "1.0". Opposer's mark describes exactly what Opposer's product is: a 1 inch piece of paper.

24. Therefore, a consumer wishing to purchase a "1.25" will be merely purchasing a pack of pieces of rolling papers that are 1.25 inches in length.

25. Consequently, in light of the above, Opposer's mark should not receive protection under the Lanham Act because there is no likelihood of confusion, and therefore, it is too weak for the purposes of this opposition.

IV. EXTENSIVE THIRD-PARTY USE OF THE "1.0", "1.25" AND "1.5" MARKS WEAKEN OPPOSER'S MARK, PRECLUDING A LABEL OF "FAMOUS" AND ANY POSSIBILITY OF DAMAGE TO OPPOSER'S MARK

26. Applicant realleges paragraph 1-25 against the notice of opposition as paragraph 26 of this section.

27. Opposer claims to have developed "considerable consumer recognition and goodwill in the One Marks, which are now among DRL's most valuable assets."

28. Opposer seeks to acquire protection for its trademark based on the statement in paragraph 27 above. However, in light of extensive third-party use of variations of Opposer's mark, Opposer's mark does not hold nearly the amount of strength it so claims.

29. Courts have held that a third-party's use of [a] mark seriously undermines any acquired distinctiveness. *Hasbro, Inc. v. Clue Computing, Inc.*, 66 F. Supp. 2d 117.

30. A third-party's use of a mark is relevant in determining fame and distinctiveness; the mark must be in substantially exclusive use. If a mark is in widespread use, it is not famous for the goods and services of a business. *Times Mirror Magazines Inc. v. Las Vegas Sports News*, 212 F.3d 157. Since Opposer's mark and other forms of the mark have, and are currently in widespread use, Opposer's mark is not famous and therefore cannot acquire the protection of a "famous mark", which is what Opposer is seeking to gain.

31. Applicant also has chosen to play on the "i" trademarking scheme that an extensive number of companies have done in the past. For example, the Apple iPhone and iPad, Walmart's iLamp desk organizer, and the iPlay brand of infant clothing.

32. A search for the trademark “1.0” on trademarks.justia.com, comes up with 1, 210 search results.

33. A search for the trademark “1.25” on trademarks.justia.com, comes up with 672 results.

34. A search for the trademark “1.5” on trademarks.justia.com, comes up with 7,514 results.

35. The following similar marks have been in use by third-parties for decades in stream of commerce:

A. The Word Mark “EZ Wider 1.0” which is also a rolling paper company and produces the exact same products as Opposer, serial no. 73537481, was filed for on May 13, 1985 and continues to be used in commerce today.

B. The Word Mark “1.5”, serial no. 77384570, was in use from January 30, 2008 to October 23, 2015 by Hitachi Home Electronics (AMERICA), Inc., a prominent electronics company.

C. The Word Mark “1.5 ML” , serial no. 77802187, has been in use since August 17th, 2009 for the purposes of describing measurement amounts for medical syringes.

D. The Word Mark “ SYSTEM 1.25”, serial no. 76251997, was granted for a couple of years before abandonment.

36. As a result of the foregoing, Opposer fails the test of a Famous mark and thus, lacks any protection under a Federal Dilution Statute.

37. In absence of a “famous” label Opposer lacks protection under a federal dilution statute, and Applicant is not in violation of 15 U.S.C. § 1052(d) as Opposer claims.

WHEREFORE, in light of Applicant's mark of "i50" not bearing any resemblance to the marks of Opposer, there is no likelihood of confusion between the two marks, and Opposer in no way would be damaged by the registration of Applicant's mark. Applicant requests that DRL's Notice of Opposition be dismissed and that ATMOS's Application for i50, Serial No. 86/604,124, be considered for registration applied.

Dated: March 14, 2016

Respectfully Yours,



Divya Khullar, Esq.
Florida Bar No. 0101116
USAPatents.com
4786 W. Commercial Blvd.
Tamarac, Florida 33319
Phone: (954) 642-2308
Fax: (754) 999-7057
assistant@usapatents.com

CERTIFICATE OF SERVICE

I hereby certify that, pursuant to 37 CFR §§ 2.101, 2.111, and 2.119, a copy of the foregoing **APPLICANT'S ANSWER TO OPPOSER'S NOTICE OF OPPOSITION AND INCORPORATED AFFIRMATIVE DEFENSES** was served upon counsel for Opposer via First-Class Mail:

Andrew S. Fraker

Neal, Gerber, & Eisenberg LLP

2 North LaSalle Street, Suite 1700

Chicago, Illinois 60602

(312) 269-8000

with a courtesy copy e-mailed to afraker@ngelaw.com on this day of March 14, 2016.